

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 13

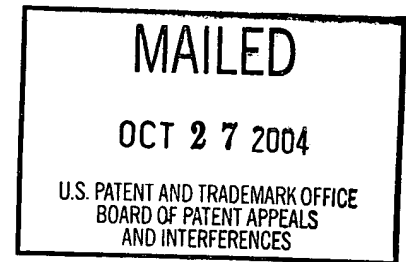
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW G. BEVAN, NIGEL R. DAVIS, and
RICHARD BORRETT

Appeal No. 2004-0640
Application No. 09/385,938

ON BRIEF



Before FLEMING, DIXON, and BLANKENSHIP, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, and 5-13, which are all of the claims pending in this application.

We **AFFIRM-IN-PART**.

BACKGROUND

Appellants' invention relates to a synchronisation modeling using templates and network management system. An understanding of the invention can be derived from a reading of exemplary claims 1 and 2, which are reproduced below.

1. In a communications network comprising a plurality of network elements, a method of providing management data describing synchronisation trail information for said network elements, said method comprising the steps of:

obtaining network element synchronisation data;

obtaining network element connectivity data; and

computing synchronisation trail information for said network elements from said synchronisation data and said connectivity data.

2. A data representation of a physical resource operating in accordance with a protocol having a plurality of layers, the representation further comprising a timing layer representing synchronisation trail information.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

| | | |
|------------------------|-----------|----------------------------------|
| Wolf | 6,081,550 | Jun. 27, 2000 |
| French et al. (French) | 6,330,601 | Dec. 11, 2001 |
| | | (Filing date Dec. 22, 1998) |
| Meier | 6,400,702 | Jun. 4, 2002 |
| | | (Eff. Filing date Jun. 26, 1995) |

Claims 1, 2, 5, 7, and 13 stand rejected under 35 U.S.C. § 102 as being anticipated by Wolf. Claims 6, 11, and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wolf in view of French. Claims 8-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wolf in view of Meier.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 11, mailed Sep. 15, 2003) for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 10, filed Jul. 31, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, we note that appellants have elected to group the claims into four separate groupings. (See brief at page 5.) Therefore, we select claims 1, 2, 6 and 8 as the representative claims.

ANTICIPATION

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **See Verdegaal Bros. Inc. v. Union Oil Co.**, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim

when the reference discloses every feature of the claimed invention, either explicitly or inherently (**see Hazani v. Int'l Trade Comm'n**, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (**see Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984)).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1. The examiner maintains that Wolf teaches the invention as recited in independent claim 1. (See answer at pages 3, 4, 10 and 11.) We agree with the examiner that Wolf teaches the invention as broadly recited in independent claim 1.

Appellants argue that the physical testing of Wolf is a different approach to "computing synchronisation trail information for said network elements from said synchronisation data and said connectivity data" as recited in independent claim 1. Appellants argue that the physical testing is not a computation from collected data and

the present invention enables synchronisation trail information to be computed from collected classes of data and enables automation of the provision of synchronisation trail information. (See brief at pages 5-6.) We disagree with appellants' conclusion and do not find any limitation as to the automation of the steps of computation or obtaining data. Therefore, this argument is not persuasive.

Appellants argue that Wolf requires prior knowledge of a designated clock path so it cannot provide a full disclosure of "synchronisation trail information." (See brief at page 6.) Appellants have identified no specific definition of the term/phrase "synchronisation trail information" in the specification, and we find no specific definition of this term/phrase. Nor have appellants identified a special meaning to the steps of obtaining "synchronisation data" and "connectivity data." Appellants identify examples of such data, but not a definition which would limit the interpretation of these claim limitations. (See brief at page 6.) Appellants argue that the passing of a marked signal and checking of the signal is not obtaining synchronisation data. We disagree with appellants.

Appellants argue that examples of connectivity data are also described in the specification and that such data is not obtained in Wolf. (See brief at page 6.) We disagree with appellants and find that appellants admit that the connectivity data is already known in Wolf. Therefore, we find that the data is "obtained." Furthermore, we find that the retrieval of this data from a storage device would meet the step of

“obtaining” as broadly recited in independent claim 1. Since we find that both classes of data (even though not the same as the examples in the specification) are obtained (maybe in a different manner), we find that they are used in the determination of the synchronisation trail information. Therefore, we find that the examiner has established a ***prima facie*** case of anticipation of independent claim 1, and we will sustain the rejection of independent claim 1 and claims 5 and 13 which are grouped therewith.

With respect to independent claim 2¹, appellants argue that Wolf does not describe or teach a protocol having a timing layer for representing synchronisation trail information. (See brief at page 7.) We agree with appellants and find no express teaching of a “data representation of a physical resource operating in accordance with a protocol having a plurality of layers, the representation further comprising a timing layer representing synchronisation trail information” as recited in independent claim 2. The examiner maintains that the representation would have been “inherent” due to the existence of synchronisation information and in its storage. We disagree with the examiner conclusion and finding that it would necessarily exist as claimed. Therefore, the examiner’s position is not well founded, and the examiner has not established a ***prima facie*** case of anticipation of dependent claim 2.

¹ Here, we note that the examiner has not applied a rejection of this claim under 35 U.S.C. § 101. Upon return of the case to the examiner, the examiner should consider a rejection of this claim under 35 U.S.C. § 101 and whether the claimed “representation” is embodied in any type of medium so as to be an article of manufacture, machine or composition of matter, or if there are any process steps to make it within one of the statutory classes of statutory subject matter.

With respect to dependent claim 7, we note that appellants have grouped this claim with independent claim 1, but have provided additionally a specific argument for patentability. (See brief at page 8.) Therefore, we will address this claim for completeness. Appellants argue that claim 7 recites selection of a network element and following the synchronisation trail to the synchronisation source. Appellants argue that in Wolf, the signal is passed away from the source rather than toward the source. (See brief at page 8.) The examiner relies upon the teachings of Wolf at column 4. (See answer at page 4.) We disagree with the examiner and find that Wolf merely teaches the manipulation of the modulation information at differing network elements and monitoring the propagation of the signal away from the source. Therefore, the examiner's position is not well founded, and the examiner has not established a ***prima facie*** case of anticipation of dependent claim 7. Therefore, we will not sustain the rejection of dependent claim 7.

OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a ***prima facie*** case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A ***prima facie*** case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to

make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellants' disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in

the prior art or that knowledge generally available to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 6.

Appellants argue that the same arguments with respect to Wolf apply and that the teachings of French do not relate to synchronisation trails and therefore the combination of the two teachings would not lead a person skilled in the art to the claimed invention. (See brief at pages 8-9.) We disagree with appellants and find that the inclusion of a graphical user interface and in graphical form would have been useful

as the examiner sets forth in the statement of the rejection at page 7 of the answer. Therefore, appellants' argument is not persuasive, and we will sustain the rejection of independent claim 6 and dependent claims 11 and 12 which are grouped therewith.

With respect to dependent claim 8, the examiner maintains that Wolf does not explicitly disclose starting the synchronisation trail at a "leafNode," but that Wolf would implicitly teach starting the synchronisation trail at a "leafNode" since the end of a tree would be the root or bottom most node of a tree/network. We disagree with the examiner and find that the examiner refers to the root of the tree as the leaf and we do not agree with the examiner's position that Wolf implicitly teaches this limitation. Nor do we find the limited network example in Wolf to suggest selections of leafNode as a start location. We find that the limitation of claim 8 requires a preferential selection of a leafNode (as defined at page 9 of the specification) which we find to be different from the root as in Meier. Therefore, we find that the examiner has not established a ***prima facie*** case of obviousness with respect to dependent claim 8, and we will not sustain the rejection of dependent claim 8.

With respect to claims 9 and 10, appellants have provided brief arguments that the combination of Wolf and Meier would not teach or suggest the invention as claimed. With respect to claim 9, we find the same limitation concerning leafNodes as with claim 8. Therefore, we find that the examiner has not established a ***prima facie***

case of obviousness with respect to dependent claim 9, and we will not sustain the rejection of dependent claim 9.

With respect to claim 10 appellants argue that neither Wolf or Meier teaches or suggests counting the number of hops to a primary reference clock. We agree with appellants that the examiner's rejection does not directly address this limitation. We find that Meier teaches the counting the hops to the root node and not counting the number of hops from a network element at the start of a synchronisation trail to a primary reference clock. Therefore, we find that the examiner has not established a *prima facie* case of obviousness with respect to dependent claim 10, and we will not sustain the rejection of dependent claim 10.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 5 and 13 under 35 U.S.C. § 102 is affirmed, the decision of the examiner to reject claims 2 and 7 under 35 U.S.C. § 102 is reversed, the decision of the examiner to reject claims 6, 11, and 12 under 35 U.S.C. § 103 is affirmed, and the decision of the examiner to reject claims 8-10 under 35 U.S.C. § 103 is reversed.


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Application No. 09/385,938

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRM-IN-PART


MICHAEL R. FLEMING
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge


HOWARD B. BLANKENSHIP
Administrative Patent Judge

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